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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appn. Number: 09/349,517
Filing Date: July 8, 1999
Inventors: Russell W. McDonald et al.
Appn. Title: MORTGAGE LOAN AND FINANCIAL SERVICES DATA
PROCESSING SYSTEM
Examiner: Ella Colbert
GAU: 3624
Docket No.: R250-001

Date Mailed: June 2, 2005

TRANSMITTAL LETTER

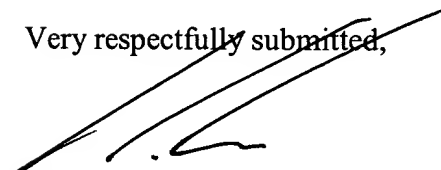
Mail Stop Amendments
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir,

Enclosed are the following:

1. Response to Notice of Non-Compliant Amendment (16 pages)
2. Appendix A: Replacement Specification (48 pages)
3. Appendix B: Markup Version of Replacement Specification (48 pages)
4. Copy of Notice of Non-Compliant Amendment
5. Petition for Extension of Time (1 month)
6. Credit Card Form in the amount of \$60.00
7. Certificate of Mailing, Mailed on: June 2, 2005
8. Prepaid Return Post Card

Very respectfully submitted,


Gregory Scott Smith
GSS LAW GROUP
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Newark, CA 94560

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Fax (510) 742-7419

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendments, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By: 
Typed Name: Evanjin M. Dasalla

Date of Deposit: June 2, 2005



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/349,517	07/08/1999	RUSSELL W. MCDONALD	1106- 2250-001	6725

23429 7590 04/08/2005

GREGORY SMITH & ASSOCIATES
3900 NEWPARK MALL ROAD, 3RD FLOOR
NEWARK, CA 94560

EXAMINER

COLBERT, ELLA

ART UNIT PAPER NUMBER

3624

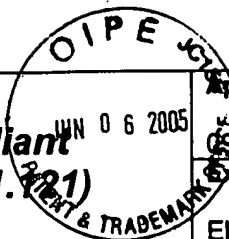
DATE MAILED: 04/08/2005

received
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C43



Please find below and/or attached an Office communication concerning this application or proceeding.

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**



Application No.

09/349,517

Examiner

Ella Colbert

Applicant(s)

MCDONALD ET AL.

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 08 June 2004 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☒ 1. Amendments to the specification:
 - ☒ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____.
- ☐ 2. Abstract:
 - ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
 - ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☒ 4. Amendments to the claims:
 - ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☐ E. Other: _____.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officelyer.pdf>.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted within the time period set forth in the final Office action.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action.

Extensions of time are available under 37 CFR 1.136(a) **only** if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

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DETAILED ACTION

1. Claims 1-3, 12-20, 22-25, 27-29, 31-43, 45, 46, 48-50, 52-56m 58-60, and 62-64 are pending. Claims 1, 12, 27-29, 32, 48, and 52-55 have been amended in the communication filed 06/08/04 as RCE and Amendment.

2. A notice of Informal or Non-Responsive RCE was mailed 07/09/04. The Examiner has no record of sending to the Applicants' a Notice of Informal or Non-Responsive RCE and cannot find where a Notice of Informal or Non-Responsive RCE was sent by anyone on 07/09/04. This notice on 07/09/04 must have been in error. However, there are some Non-Compliant issues as set forth here below.

The Amendment to the Specification and Claims filed 06/08/04 is not fully compliant with the accepted amendment practice for amendments (MPEP 714.03). Claims 49 and 56 do not specify whether the claim was previously presented or amended. The Specification should be resubmitted as a substitute Specification in its entirety without the markings and the pages properly numbered in sequential order.

Applicants' are respectfully requested to see the attachments to this Action for the accepted amendment practice.

Since the above-mentioned appears to be *bona fide*, Applicants' are given a time period of **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the corrections in order to avoid abandonment. Extensions of this time period maybe granted under 37 CFR 1.136(a).

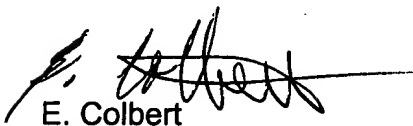
This action is **NON-FINAL**.

Inquiries

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
March 28, 2005

All amendments filed on or after July 30, 2003 must comply with 37 CFR 1.121 as revised in the notice of final rule making published in the *Federal Register* on June 30, 2003 at 65 *Fed. Reg.* 38611. The manner of making amendments has been revised to assist in the implementation of beginning-to-end electronic image processing of patent applications. Specifically, changes have been made to facilitate electronic image data capture and processing and streamline the patent application process. If an amendment filed on or after July 30, 2003 does not comply with revised 37 CFR 1.121, the Office will notify applicants via a Notice of Non-Compliant Amendment that the amendment is not accepted. See MPEP § 714.03.

The revised amendment practice is summarized as follows.

A. Amendment Sections

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet to facilitate separate indexing and electronic scanning of each section of an amendment document for placement in an image file wrapper.

It is recommended that applicants use the following format when submitting amendment papers. The amendment papers should include, in the following order:

- (A) a cover sheet, or introductory comments, providing the appropriate application information (e.g., application number, applicant, filing date) and which serves as a table of contents to the amendment document by indicating on what page of the amendment document each of the following sections begin;
- (B) a section (must begin on a separate sheet) entitled "Amendments to the Specification" (if there are any amendments to the specification). This section should include all amendments to the specification including amendments to the abstract of the disclosure;
- (C) a section (must begin on a separate sheet) entitled "Amendments to the Claims" which includes a complete listing of all claims ever presented in the application (if there are any amendments to the claims);
- (D) a section (must begin on a separate sheet) entitled "Amendments to the Drawings" in which all changes to the drawings are discussed (if there are any amendments to the drawings);
- (E) a remarks section (must begin on a separate sheet); and
- (F) any drawings being submitted including any "Replacement Sheet," "New Sheet," or "Annotated Marked-Up Drawings."

B. < Amendments to the Specification

>Amendments to the specification, other than the claims, computer listings (37 CFR 1.96) and sequence listings (37 CFR 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification.< In order to delete, replace or add a paragraph to the specification of an application, the amendment must unambiguously identify the paragraph to be modified either by paragraph number (see MPEP § 608.01), page and line, or any other unambiguous method and be accompanied by **>any replacement or new paragraph(s). Replacement paragraphs must include markings to show the changes. A separate clean version of any replacement paragraphs is not required. Any new paragraphs must be presented in clean form without any markings (i.e., underlining)<.

Where paragraph numbering has been included in an application as provided in 37 CFR 1.52(b)(6), applicants can easily refer to a specific paragraph by number when presenting

an amendment. If a numbered paragraph is to be replaced by a single paragraph, the added replacement paragraph should be numbered with the same number of the paragraph being replaced. Where more than one paragraph is to replace a single original paragraph, the added paragraphs should be numbered using the number of the original paragraph for the first replacement paragraph, followed by increasing decimal numbers for the second and subsequent added paragraphs, e.g., original paragraph [0071] has been replaced with paragraphs [0071], [0071.1], and [0071.2]. If a numbered paragraph is deleted, the numbering of the subsequent paragraphs should remain unchanged.

37 CFR 1.121(b)(1)(ii) requires that the ~~full~~ text of any replacement paragraph be provided with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted subject matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show the deletion of five or fewer consecutive characters (e.g., ~~error~~). The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived (e.g., deletion of the number "4" must be shown as ~~[[4]]~~). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change (e.g., ~~number 4 as~~ number 14 as).

For added paragraphs, 37 CFR 1.121(b)(2)(iii) requires that the full text of any added paragraph(s) be presented in clean form without any underlining. Similarly, under 37 CFR 1.121(b)(2)(iv), a marked up version does not have to be supplied for any deleted paragraph(s). It is sufficient to merely indicate or identify any paragraph that has been deleted. The instruction to delete may identify a paragraph by its paragraph number, page and line number, or include a few words from the beginning, and end, or the paragraph, if needed for paragraph identification.

Applicants are also permitted to amend the specification by replacement sections (e.g., as provided in 37 CFR 1.77(b), 1.154(b), or 1.163(c)). As with replacement paragraphs, the amended version of a replacement section is required to be provided ~~with~~ markings to show all the changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted subject matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show the deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

Applicants are also permitted to amend the specification by submitting a substitute specification, provided the requirements of 37 CFR 1.125(b) and (c) are met. An accompanying separate marked up version showing the changes in the specification relative to the previous version is also required.

Any ~~previously deleted paragraph or section~~ can only be reinstated by a subsequent amendment presenting the previously deleted subject matter. A direction by applicant to remove a previously entered amendment will not be permitted.

C. ~~Amendments to the Claims~~

~~Each~~ amendment document that includes a change to an existing claim, including the deletion of an existing claim, or submission of a new claim, must include a complete listing of all claims in the application. After each claim number, the status of the claim must be indicated in a parenthetical expression, and the text of each claim under examination as well as all withdrawn claims (each with markings if any, to show current changes) must be

presented. The listing will serve to replace all prior versions of the claims in the application.

- (A) The current status of all of the claims in the application, including any previously canceled or withdrawn claims, must be given. Status is indicated in a parenthetical expression following the claim number by one of the following: (original), (currently amended), (previously presented), (canceled), (withdrawn), (new), or (not entered). The text of all pending claims under examination and withdrawn claims must be submitted each time any claim is amended. Canceled and not entered claims must be listed by only the claim number and status, without presenting the text of the claims.
- (B) All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by strike-through (for deleted matter) or underlining (for added matter) with 2 exceptions: (1) for deletion of five or fewer consecutive characters, double brackets may be used (e.g., [[eroor]]); (2) if strike-through cannot be easily perceived (e.g., deletion of number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change (e.g., ~~number 4 as~~ number 14 as). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended" or "withdrawn" will include markings.
- (C) The text of pending claims not being currently amended, including withdrawn claims, must be presented in clean version, i.e., without any markings. Any claim presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.
- (D) A claim being canceled must be indicated as "canceled;" the text of the claim must not be presented. Providing an instruction to cancel is optional.
- (E) Any claims added by amendment must be indicated as "new" and the text of the claim must not be underlined.
- (F) All of the claims in each amendment paper must be presented in ascending numerical order. Consecutive canceled or not entered claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

A canceled claim can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

Example of listing of claims:

Claims 1-5 (canceled)

Claim 6 (withdrawn): A process for molding a bucket.

Claim 7 (previously presented): A bucket with a handle.

Claim 8 (currently amended): A bucket with a ~~green-blue~~ handle.

Claim 9 (withdrawn): The process for molding a bucket of claim 6 using molten plastic material.

- Claim 10 (original): The bucket of claim 8 with a wooden handle.
- Claim 11 (canceled)
- Claim 12 (previously presented): A bucket having a circumferential upper lip.
- Claim 13 (not entered)
- Claim 14 (new): A bucket with plastic sides and bottom.<

37 CFR 1.121(g) permits the Office to make amendments to the specification, including the claims, by examiner's amendments without paragraph/section/claim replacement in the interest of expediting prosecution and reducing cycle time. Additions or deletions of subject matter in the specification, including the claims, may be made by instructions to make the change at a precise location in the specification or the claims. >Examiner's amendments do not need to comply with paragraphs (b)(1), (b)(2), or (c) of 37 CFR 1.121.< See MPEP § 1302.04.

**

*>D. < *Amendments to the Drawing*

**>Any changes to an application drawing must comply with 37 CFR 1.84 and must be submitted on a replacement sheet of drawings. The replacement sheet of drawings must be an attachment to the amendment document and must be identified in the top margin as "Replacement Sheet." The replacement drawing sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change to the drawings. A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.<

An explanation of the changes made must be presented in >the "Amendments to the Drawings" or< the remarks section of the amendment >document<. If the changes to the drawing figure(s) are not approved by the examiner, applicant will be notified in the next Office action. **

>III. < **AMENDMENT IN REEXAMINATION PROCEEDINGS > AND REISSUE APPLICATIONS<**

>Amendments in reissue applications must be made in accordance with 37 CFR 1.173. Amendments in *ex parte* and *inter partes* reexamination proceedings must be made in accordance with 37 CFR 1.530.< In patent-owner-filed > *ex parte*< reexaminations, the patent owner may amend at the time of the request for > *ex parte*< reexamination in accordance with 37 CFR 1.510(e). In any > *ex parte*< reexamination proceeding, no amendment or response can be filed between the date of the request for > *ex parte*< reexamination and the order for > *ex parte*< reexamination. See 37 CFR 1.530(a). Following the order for > *ex parte*< reexamination under 37 CFR 1.525 and prior to the examination phase of *> *ex parte*< reexamination proceeding, an amendment may be filed only with the patent owner's statement under 37 CFR 1.530(b). During the examination phase of the > *ex parte*< reexamination proceeding, an amendment may be filed:

- (A) after the first examination as specified in 37 CFR 1.112;
- (B) after final rejection or an appeal has been taken, if the amendment meets the

criteria of 37 CFR 1.116; and

(C) when and as specifically required by the examiner.

See also MPEP § 714.12.

For amendments in > *ex parte* < reexamination proceedings see MPEP § 2250 and § 2266. >For amendments by patent owner in an *inter partes* reexamination proceeding, see MPEP § 2666.01 and § 2672. For amendments in reissue applications, see MPEP § 1453.<

714.01 Signatures to Amendments

An amendment must be signed by a person having authority to prosecute the application. An unsigned or improperly signed amendment will not be entered. See MPEP § 714.01(a).

To facilitate any telephone call that may become necessary, it is recommended that the complete telephone number with area code and extension be given, preferably near the signature.

714.01(a) [R-2] Unsigned or Improperly Signed Amendment

37 CFR 1.33. Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

(b) *Amendments and other papers*. Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

- (1) A registered attorney or agent of record appointed in compliance with § 1.34(b);
- (2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a);
- (3) An assignee as provided for under § 3.71(b) of this chapter; or
- (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

An unsigned amendment or one not properly signed by a person having authority to prosecute the application is not entered. This applies, for instance, where the amendment is signed by only one of two applicants and the one signing has not been given a power of attorney by the other applicant.

If copies of papers which require an original signature as set forth in 37 CFR 1.4(e) are filed, the signature must be applied after the copies are made. MPEP § 714.07.

When an unsigned or improperly signed amendment is received the amendment will be listed **>in the contents of the application file<, but not entered. The examiner will notify applicant of the status of the application, advising him or her to furnish a duplicate amendment properly signed or to ratify the amendment already filed. In an application not under final rejection, applicant should be given a 1-month time period in which to ratify the previously filed amendment (37 CFR 1.135(c)).

Applicants may be advised of unsigned amendments by use of form paragraph 7.84.01.

¶ 7.84.01 Paper Is Unsigned

The proposed reply filed on [1] has not been entered because it is unsigned. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Sometimes problems arising from unsigned or improperly signed amendments may be disposed of by calling in the local representative of the attorney or agent of record, since

he or she may have the authority to sign the amendment.

An amendment signed by a person whose name is known to have been removed from the registers of attorneys and agents under the provisions of 37 CFR 10.11 is not entered. The file and unentered amendment are submitted to the Office of Enrollment and Discipline for appropriate action.

714.01(c) Signed by Attorney or Agent Not of Record

See MPEP § 405. A registered attorney or agent acting in a representative capacity under 37 CFR 1.34, may sign amendments even though he or she does not have a power of attorney in the application. See MPEP § 402.

714.01(d) Amendment Signed by Applicant but Not by Attorney or Agent of Record

If an amendment signed by the applicant is received in an application in which there is a duly appointed attorney or agent, the amendment should be entered and acted upon. Attention should be called to 37 CFR 1.33(a) in patent applications and to 37 CFR 1.33(c) in reexamination proceedings. Two copies of the action should be prepared, one being sent to the attorney and the other directly to the applicant. The notation: "Copy to applicant" should appear on the original and on both copies.

714.01(e) [R-2] Amendments Before First Office Action

A preliminary amendment is an amendment that is received in the Office on or before the mail date of the first Office action under 37 CFR 1.104. See 37 CFR 1.115(a). **>Since a request for continued examination (RCE) is not a new application, an amendment filed before the first Office action after the filing of the RCE is not a preliminary amendment. See MPEP § 706.07(h).

I. PRELIMINARY AMENDMENTS MUST COMPLY WITH 37 CFR 1.121

Any preliminary amendment, regardless of when it is filed, must comply with 37 CFR 1.121, e.g., the preliminary amendment must include a complete listing of all of the claims and each section of the amendment must begin on a separate sheet of paper. See MPEP § 714. Preliminary amendments made in a transmittal letter of the application will not comply with 37 CFR 1.121. For example, applicants should include the reference to a prior filed application in the first sentence of the specification following the title or in an application data sheet in compliance with 37 CFR 1.78 instead of submitting the reference in a preliminary amendment in a transmittal letter. See MPEP § 201.11. If a preliminary amendment fails to comply with 37 CFR 1.121, applicant will be notified by way of a Notice of Non-Compliant Amendment and given a non-extendable period of one month to bring the amendment into compliance with 37 CFR 1.121. If the applicant takes no corrective action, examination of the application will commence without consideration of the proposed changes in the non-compliant preliminary amendment. See MPEP § 714.03.

Filing a preliminary amendment is not recommended because the changes made by the preliminary amendment may not be reflected in the patent application publication even if the preliminary amendment is referred to in an oath or declaration. If there is insufficient time to have the preliminary amendment be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun, the preliminary amendment will not be reflected in the patent application publication. Technical preparations for publication of an application generally begin four months prior to the projected date of publication. For more information on publication of applications, see MPEP § 1121. Applicants may avoid preliminary amendments by incorporating any desired amendments into the text of the specification including a new set of claims, even where the application is a continuation or divisional application of a previously filed patent application. In such a continuation or divisional application, a clean copy of a specification (i.e., reflecting amendments made in the parent application) may be submitted together

with a copy of the oath or declaration from the previously filed application so long as no new matter is included in the specification. See 37 CFR 1.63(d)(1)(iii) and MPEP § 201.06(c).

II. PRELIMINARY AMENDMENTS FILED WITH THE APPLICATION<

A preliminary amendment not filed along with the original application does not enjoy the status of part of the original disclosure. See MPEP § 608.04(b). Where an application filed under 37 CFR 1.53(b) is filed without a signed oath or declaration and such application is accompanied by an amendment, that amendment is considered a part of the original disclosure. The subsequently filed oath or declaration must refer to both the application and the amendment. >If the subsequently filed oath or declaration refers to the application but does not refer to the amendment, applicants will be required to submit a supplemental oath or declaration referring to both the application and the amendment filed with the original application.< Any copy of the application as filed must include a copy of the amendment as well, particularly where certified copies for priority purposes are requested.

****** Any amendment canceling claims in order to reduce the filing fee should be filed with the application. ****** See MPEP § 506. >If a preliminary amendment accompanying a nonprovisional application cancels claims, it will be effective to diminish the number of claims to be considered in calculating the filing fee. See MPEP § 607. If the preliminary amendment accompanying the nonprovisional application cancels all claims without presenting any new claims, the Office will not enter such an amendment. See *Exxon Corp. v. Phillips Petroleum Co.*, 265 F.3d 1249, 60 USPQ2d 1369 (Fed. Cir. 2001) and MPEP § 601.01(e). Thus, the application will not be denied a filing date merely because such a preliminary amendment was submitted on filing. For fee calculation purposes, the Office will treat such an application as containing only a single claim.

III. PRELIMINARY AMENDMENTS MUST BE TIMELY

Any preliminary amendments should either accompany the application or be filed after the application has received its application number and filing date so that the preliminary amendments would include the appropriate identifications (e.g., the application number and filing date). See MPEP § 502. Any amendments filed after the mail date of the first Office action is not a preliminary amendment. If the date of receipt (37 CFR 1.6) of the amendment is later than the mail date of the first Office action and is not responsive to the first Office action, the Office will not mail a new Office action, but simply advise the applicant that the amendment is nonresponsive to the first Office action and that a responsive reply must be timely filed to avoid abandonment. See MPEP § 714.03.< A preliminary amendment will be entered unless it is disapproved by the *>Director<. A preliminary amendment may be disapproved by the *>Director< if the preliminary amendment unduly interferes with the preparation of an Office action. 37 CFR 1.115(b). See MPEP § 714.03(a).

714.02 [R-2] Must Be Fully Responsive

37 CFR 1.111. Reply by applicant or patent owner to a non-final Office action.

(a)

(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See § 1.135 and 1.136 for time for reply to avoid abandonment.

****>**

(2) A second (or subsequent) supplemental reply will be entered unless disapproved by the Director. A second (or subsequent) supplemental reply may be disapproved if the second (or subsequent) supplemental reply unduly interferes with an Office action being prepared in response to the previous reply. Factors that will be considered in disapproving a second (or subsequent) supplemental reply include:<

(i) The state of preparation of an Office action responsive to the previous reply as of the date of receipt (§ 1.6) of the second (or subsequent) supplemental reply by the Office; and

(ii) The nature of any changes to the specification or claims that would result from entry of the second (or subsequent) supplemental reply.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

In all cases where reply to a requirement is indicated as necessary *for further consideration of the claims, or where allowable subject matter has been indicated in an application, a complete reply must either comply with the formal requirements or specifically traverse each one not complied with.

Drawing and specification corrections, presentation of a new oath and the like are generally considered as formal matters, although the filing of drawing corrections in reply to an objection to the drawings cannot normally be held in abeyance. However, the line between formal matter and those touching the merits is not sharp, and the determination of the merits of an application may require that such corrections, new oath, etc., be insisted upon prior to any indication of allowable subject matter.

The claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in 37 CFR 1.121(c). The requirements of 37 CFR 1.111(b) must be complied with by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments.

An amendment submitted after a second or subsequent non-final action on the merits which is otherwise responsive but which increases the number of claims drawn to the invention previously acted upon is not to be held not fully responsive for that reason alone. (See 37 CFR 1.112, MPEP § 706.)

The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06.

An amendment which does not comply with the provisions of 37 CFR 1.121(b)**>, (c), (d), and (h) may be held not fully responsive **. See MPEP § 714.22.

Replies to requirements to restrict are treated under MPEP § 818.

714.03 [R-2] Amendments Not Fully Responsive, Action To Be Taken

37 CFR 1.135. Abandonment for failure to reply within time period.

(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

An examiner may treat an amendment not fully responsive to a non-final Office action by:

(A) accepting the amendment as an adequate reply to the non-final Office action to avoid abandonment under 35 U.S.C. 133 and 37 CFR 1.135;

(B) notifying the applicant that the reply must be completed within the remaining period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)) to avoid abandonment; or

(C) setting a new time period for applicant to complete the reply pursuant to 37 CFR 1.135(c).

The treatment to be given to the amendment depends upon:

(A) whether the amendment is *bona fide*;

(B) whether there is sufficient time for applicant's reply to be filed within the time period for reply to the non-final Office action; and

(C) the nature of the deficiency.

If an amendment submitted **>on or after July 30, 2003<, fails to comply with 37 CFR 1.121 (as revised on **>June 30, 2003<), the Office will notify applicant by a Notice of Non-Compliant Amendment, that the amendment fails to comply with the requirements of 37 CFR 1.121 and applicant will be given a period of time in which to comply with the rule. >Applicant's reply to a Notice of Non-Compliant Amendment should consist of a corrected version of only that portion of the amendment which previously failed to comply with 37 CFR 1.121. It is not necessary for applicant to resubmit the entire amendment document.< If the amendment that fails to comply with the requirements of the rule is a preliminary amendment, the Legal Instruments Examiner (LIE) will send the Notice which sets a time limit of 30 days or one month, whichever is later, for reply. No extensions of time are permitted. Failure to submit a timely reply will result in the application being examined without entry of the preliminary amendment. If the amendment which fails to comply with the requirements of the rule is an amendment after a non-final Office action, the LIE will send the Notice which sets a time limit of 30 days or one month, whichever is later, for reply (37 CFR 1.135). Extensions of time are permitted (37 CFR 1.136(a)). Failure to reply to this Notice will result in abandonment of the application. See MPEP § 714.22 for treatment of non-compliant amendments after final rejection.

Where an amendment substantially responds to the rejections, objections, or requirements in a non-final Office action (and is a *bona fide* attempt to advance the application to final action) but contains a minor deficiency (e.g., fails to treat every rejection, objection, or requirement), the examiner may simply act on the amendment and issue a new (non-final or final) Office action. The new Office action may simply reiterate the rejection, objection, or requirement not addressed by the amendment (or otherwise indicate that such rejection, objection, or requirement is no longer applicable). This course of action would not be appropriate in instances in which an amendment contains a serious deficiency (e.g., the amendment is unsigned or does not appear to have been filed in reply to the non-final Office action). Where the amendment is *bona fide* but contains a serious omission, the examiner should: A) if there is sufficient time remaining for applicant's reply to be filed within the time period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)), notify applicant that the omission must be supplied within the time period for reply; or B) if there is insufficient time remaining, issue an Office action setting a 1-month time period to complete the reply pursuant to 37 CFR 1.135(c). In either event, the examiner should not further examine the application on its merits unless and until the omission is timely supplied.

If a new time period for reply is set pursuant to 37 CFR 1.135(c), applicant must supply the omission within this new time period for reply (or any extensions under 37 CFR 1.136(a) thereof) in order to avoid abandonment of the application. The applicant, however, may file a continuing application during this period (in addition or as an alternative to supplying the omission), and may also file any further reply as permitted

under 37 CFR 1.111.

Where there is sufficient time remaining in the period for reply (including extensions under 37 CFR 1.136(a)), the applicant may simply be notified that the omission must be supplied within the remaining time period for reply. This notification should be made, if possible, by telephone, and, when such notification is made by telephone, an interview summary record (see MPEP § 713.04) must be completed and entered into the file of the application to provide a record of such notification. When notification by telephone is not possible, the applicant must be notified in an Office communication that the omission must be supplied within the remaining time period for reply. For example, when an amendment is filed shortly after an Office action has been mailed, and it is apparent that the amendment was not filed in reply to such Office action, the examiner need only notify the applicant (preferably by telephone) that a reply responsive to the Office action must be supplied within the remaining time period for reply to such Office action.

The practice set forth in 37 CFR 1.135(c) does not apply where there has been a deliberate omission of some necessary part of a complete reply; rather, 37 CFR 1.135(c) is applicable only when the missing matter or lack of compliance is considered by the examiner as being "inadvertently omitted." For example, if an election of species has been required and applicant does not make an election because he or she believes the requirement to be improper, the amendment on its face is not a "*bona fide* attempt to advance the application to final action" (37 CFR 1.135(c)), and the examiner is without authority to postpone decision as to abandonment. >Similarly, an amendment that would cancel all of the claims in an application and does not present any new or substitute claims is not a *bona fide* attempt to advance the application to final action. The Office will not enter such an amendment. See *Exxon Corp. v. Phillips Petroleum Co.*, 265 F.3d 1249, 60 USPQ2d 1368 (Fed. Cir. 2001). If there is time remaining to reply to the non-final Office action (or within any extension of time pursuant to 37 CFR 1.136(a)), applicant will be notified to complete the reply within the remaining time period to avoid abandonment.< Likewise, once an inadvertent omission is brought to the attention of the applicant, the question of inadvertence no longer exists. Therefore, a second Office action giving another new (1 month) time period to supply the omission would not be appropriate under 37 CFR 1.135(c).

37 CFR 1.135(c) authorizes, but does not require, an examiner to give the applicant a new time period to supply an omission. Thus, where the examiner concludes that the applicant is attempting to abuse the practice under 37 CFR 1.135(c) to obtain additional time for filing a reply (or where there is sufficient time for applicant's reply to be filed within the time period for reply to the non-final Office action), the examiner need only indicate by telephone or in an Office communication (as discussed above) that the reply must be completed within the period for reply to the non-final Office action or within any extension pursuant to 37 CFR 1.136(a) to avoid abandonment.

The practice under 37 CFR 1.135(c) of giving applicant a time period to supply an omission in a *bona fide* reply does not apply after a final Office action. Amendments after final are approved for entry only if they place the application in condition for allowance or in better form for appeal. Otherwise, they are not approved for entry. See MPEP § 714.12 and § 714.13. Thus, an amendment should be denied entry if some point necessary for a complete reply under 37 CFR 1.113 (after final) was omitted, even if the omission was through an apparent oversight or inadvertence. Where a submission after a final Office action or appeal (e.g., an amendment under 37 CFR 1.116) does not place the application in condition for allowance, the period for reply under 37 CFR 1.113 continues to run until a reply under 37 CFR 1.113 (i.e., a notice of appeal or an amendment that places the application in condition for allowance) is filed. The nature of the omission (e.g., whether the amendment raises new issues, or would place the

application in condition for allowance but for it being unsigned or not in compliance with 37 CFR 1.121) is immaterial. The examiner cannot give the applicant a time period under 37 CFR 1.135(c) to supply the omission; however, applicant may obtain additional time under 37 CFR 1.136(a) to file another or supplemental amendment in order to supply the omission.

When a reply to a final Office action substantially places the application in condition for allowance, an examiner may request that the applicant (or representative) authorize an examiner's amendment to correct the omission and place the application in condition for allowance, in which case the date of the reply is the date of such authorization (and not the date the incomplete reply was filed). An examiner also has the authority to enter the reply, withdraw the finality of the last Office action, and issue a new Office action, which may be a non-final Office action, a final Office action (if appropriate), or an action closing prosecution on the merits in an otherwise allowable application under *Ex parte Quayle*, 25 USPQ 74, 1935 C.D. 11, 435 O.G. 213 (Comm'r Pat. 1935) (if appropriate). These courses of action, however, are solely within the discretion of the examiner. It is the applicant's responsibility to take the necessary action in an application under a final Office action to provide a complete reply under 37 CFR 1.113.

Where there is an informality as to the fee in connection with an amendment to a non-final Office action presenting additional claims, the applicant is notified by the technical support staff**. See MPEP § 607 and § 714.10.

Form paragraph 7.95, and optionally form paragraph 7.95.01, should be used where a *bona fide* reply is not fully responsive.

¶ 7.95 *Bona Fide, Non-Responsive Amendments*

The reply filed on [1] is not fully responsive to the prior Office action because of the following omission(s) or matter(s): [2]. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Examiner Note

This practice does not apply where there has been a deliberate omission of some necessary part of a complete reply, or where the application is subject to a final Office action. Under such cases, the examiner has no authority to grant an extension if the period for reply has expired. See form paragraph 7.91.

¶ 7.95.01 *Lack of Arguments in Response*

Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

Examiner Note

1.
This form paragraph must be preceded by form paragraph 7.95.
2.
This form paragraph is intended primarily for use in *pro se* applications.

Printer Friendly

09/349,517

MORTGAGE LOAN AND FINANCIAL SERVICES DATA PROCESSING SYSTEM

Transaction History

Date	Contents Description
04-08-2005	Mail Miscellaneous Communication to Applicant
04-03-2005	Miscellaneous Action with SSP
01-31-2005	Date Forwarded to Examiner
12-30-2004	Response after Non-Final Action
12-30-2004	Request for Extension of Time - Granted
07-09-2004	Mail Notice of Informal or Non-Responsive RCE Amendment
07-09-2004	Notice of Informal or Non-Responsive RCE Amendment.
07-09-2004	Date Forwarded to Examiner
07-09-2004	Date Forwarded to Examiner
06-08-2004	Request for Continued Examination (RCE)
07-09-2004	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)
07-09-2004	IFW TSS Processing by Tech Center Complete
07-08-1999	Oath or Declaration Filed (Including Supplemental)
06-08-2004	Workflow incoming amendment IFW
06-08-2004	Workflow - Request for RCE - Begin
04-27-2004	Mail Examiner Interview Summary (PTOL - 413)
04-21-2004	Examiner Interview Summary Record (PTOL - 413)
03-09-2004	Mail Final Rejection (PTOL - 326)
03-08-2004	Final Rejection
01-02-2004	Date Forwarded to Examiner
12-08-2003	Response after Non-Final Action
09-08-2003	Information Disclosure Statement (IDS) Filed
09-08-2003	Information Disclosure Statement (IDS) Filed
10-23-2003	Mail Non-Final Rejection
10-22-2003	Non-Final Rejection
07-31-2003	Mail Miscellaneous Communication to Applicant
07-31-2003	Miscellaneous Communication to Applicant - No Action Count
08-14-2003	Date Forwarded to Examiner
05-05-2003	Response to Election / Restriction Filed
05-05-2003	Request for Extension of Time - Granted
04-24-2003	Mail Examiner Interview Summary (PTOL - 413)
04-21-2003	Examiner Interview Summary Record (PTOL - 413)
02-24-2003	Mail Restriction Requirement
02-13-2003	Requirement for Restriction / Election
02-13-2003	Date Forwarded to Examiner

04-22-2002	Response after Non-Final Action
04-22-2002	Request for Extension of Time - Granted
02-13-2003	Case Docketed to Examiner in GAU
08-02-2002	Mail Notice of Rescinded Abandonment
08-02-2002	Notice of Rescinded Abandonment in TCs
02-13-2003	Case Docketed to Examiner in GAU
02-10-2003	Case Docketed to Examiner in GAU
02-02-2003	Transfer Inquiry to GAU
08-02-2002	Petition to Revive Application - Granted
06-14-2002	Petition Entered
06-18-2002	Miscellaneous Incoming Letter
06-18-2002	Correspondence Address Change
06-18-2002	Change in Power of Attorney (May Include Associate POA)
05-06-2002	Mail Abandonment for Failure to Respond to Office Action
05-03-2002	Abandonment for Failure to Respond to Office Action
05-03-2002	Case Docketed to Examiner in GAU
04-23-2002	Case Docketed to Examiner in GAU
04-23-2002	Case Docketed to Examiner in GAU
01-16-2002	Mail Notice of Informal or Non-Responsive Amendment
01-16-2002	Date Forwarded to Examiner
01-04-2002	Informal or Non-Responsive Amendment after Examiner Action
01-04-2002	Response after Non-Final Action
11-13-2001	Case Docketed to Examiner in GAU
09-26-2001	Mail Notice of Informal or Non-Responsive Amendment
09-17-2001	Informal or Non-Responsive Amendment after Examiner Action
09-17-2001	Request for Extension of Time - Granted
09-17-2001	Request for Extension of Time - Granted
05-07-2001	Mail Non-Final Rejection
05-04-2001	Non-Final Rejection
03-09-2001	Case Docketed to Examiner in GAU
10-27-1999	Case Docketed to Examiner in GAU
08-09-1999	Application Dispatched from OIPE
07-30-1999	IFW Scan & PACR Auto Security Review
07-15-1999	Initial Exam Team nn

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